



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,661	12/14/2000	Arturo A. Rodriguez	A-6280	8279
7590 03/03/2009 Scientific-Atlanta Inc Intellectual Property Dept MS 4.3.518 5030 Sugarloaf Parkway Lawrenceville, GA 30044				
EXAMINER AN, SHAWN S				
ART UNIT 2621		PAPER NUMBER		
MAIL DATE 03/03/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/736,661

**Applicant(s)**

RODRIGUEZ ET AL.

**Examiner**

SHAWN AN

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38, 53-55, 66-78, 80-82 and 85-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38, 53-55, 66-78, 80-82 and 85-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## SUPPLEMENTAL ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 38, 53, 55, 66-77, 82, 85-86, and 88 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Claims 38, 53, 55, and 66 pertain to a method and the computer readable medium containing a program comprising logic for performing a method directed to a series of steps at least drawn for providing ..., receiving ..., determining ..., retrieving ..., and transferring the retrieved video frames without practical application that produces any useful, tangible, and concrete results. Since dependent claims 67-77, 82, 85-86, and 88 are directed to further limitations based on the method and the program executed method, claims 38, 53, 55, 66-77, 82, 85-86, and 88 as a whole do not fall within the statutory classes set forth in 35 U.S.C. 101.

3. Claims 66-70 are rejected under 35 U.S.C. 101 because the preamble of claimed invention is directed to non-statutory subject matter.

Claim 66 comprises non-statutory subject matter, since Applicant identifies/defines a computer readable medium can be any means that can contain, store, communicate, propagate (such as carrier wave), or transport the program for use, and the computer readable medium can be an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium (Applicant, page 31, 3<sup>rd</sup> Para.), wherein the propagation medium is considered non-statutory subject matter.

Art Unit: 2621

Furthermore, since dependent claims 67-70 are directed to further limitations based on the independent claim 66, claims 66-70 as a whole do not fall within the statutory classes set forth in 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 54, 78, 80-81, and 87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The independent claim 54 contains a subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

On claim 54, the recited "logic configured to ...," does not seem to have any support in the Applicant's specification and drawings. Furthermore, since dependent claims 78, 80-81, and 87 are directed to further limitations based on the independent claim 54, claims 54, 78, 80-81, and 87 as a whole do not fall within the statutory classes set forth in 35 U.S.C. 112.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn An* whose telephone number is 571-272-7324.
7. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAWN AN/

Primary Examiner, Art Unit 2621

3/01/09